

### **REMARKS**

Claims 1-11, 13, 14, 30, and 49-70 are pending upon entry of this Amendment. By this Amendment, claims 40-48 are canceled without prejudice; Applicants retain the right to pursue these claims in a Divisional application. Also by this Amendment, new claims 67-70 are added. There are a total of 36 pending claims, four of which are independent.

#### ***Amendments***

Claims 1-11, 13, 14, 67, and 68 are method claims that generally correspond to Beauregard claims 51-63, 69, 70. Numerous changes are made by the amendments. New claims 67 and 69 reflect features extracted from independent claims 1 and 51, respectively. New claims 68 and 70 clarify that the NIC manager can also handle network traffic for components other than to and from the VMs.

Each of the independent claims is amended to clarify that the data being transferred is an outgoing data frame. Claims 1 and 51 are additionally modified to provide that certain elements of the methods take place within a component of the virtualization software. Various other minor claim restructurings are also implemented. Dependent claims are amended primarily for consistency.

Independent claims 30 and 64 are amended to clarify that the first and second NICs are physical NICs. Claims 30 and 64 are further amended to couple the decision as to whether to transmit the outgoing data frame or discard the outgoing data frame with the determination as to whether the VM that provided the outgoing data frame had higher priority or lower priority. Claims 49, 50, 65 and 66, depending from claims 30 or 64, are likewise amended for consistency.

Previously withdrawn claims 40-48 are canceled without prejudice.

No new matter is entered by this Amendment.

### *Specification*

#### I. Objection of the Specification under 37 C.F.R. § 1.75(d)(1)

The specification is under objection for “failing to provide a proper antecedent basis for the claimed subject matter.” In particular, the Office Action states that “there appears to be no antecedent basis for the term ‘computer-readable medium’ as used in new claims 51-66” (Office Action, bottom of page 3).

Applicants respectfully traverse because the terms are well known terms of art, and are clear and definite when read in light of the specification as a whole. Furthermore, Applicants respectfully note that no rejection under 35 U.S.C. § 112 second paragraph were made against the claims containing the allegedly objectionable phrase, which suggests that the claims and these terms are, in fact, definite.

The Office Action relies on 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o) in making this objection. 37 C.F.R. § 1.75(d)(1) states, “The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description” (emphasis added). MPEP 608.01(o) likewise states that “The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import; and in mechanical cases, it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts therein to which the term applies” (emphasis added). It is noted that this Rule and this MPEP section are directed to situations where a claim term is unclear and whose meaning cannot be ascertained by review of the specification. They do *not* contain an explicit requirement that each term or phrase used in the claims be matched with an antecedent in the specification, only that such terms and phrases “find clear support . . . so that the meaning of the terms in the claims are ascertainable by reference to the description.”

However, the Office Action does not anywhere suggest that the meanings of the terms are unclear. For instance, The Office Action does not reject claims 37-48 for being indefinite under 35 U.S.C. § 112, nor is the specification objected to under 35 U.S.C. § 112 for lacking support for

these terms under the Written Description requirement, which suggests acknowledgement that Applicants indeed had possession of the concept of “computer-readable medium” at the time the application was filed. Since the meanings of the terms are clear, Applicants respectfully submit that objection to the specification under 37 C.F.R. § 1.75(d)(1) is inappropriate.

As stated in MPEP 2173.05(e), “The mere fact that a term or phrase used in the claim has no antecedent basis in the specification disclosure does not mean, necessarily, that the term or phrase is indefinite. There is no requirement that the words in the claim must match those used in the specification disclosure. Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision” (emphasis added).

Applicants accordingly respectfully submit that the term, “computer-readable medium,” being a well known term in the field of computer software, to which the present application is directed, meets the test of “reasonable clarity and precision” and is sufficiently supported by the specification, although these precise words are not used. Reconsideration and retraction of this objection is respectfully requested.

## 2. Requirement of correction of claims 51-66.

The Office Action does not cite any authority to require Applicants to “correct” claims 51-66. Applicants respectfully traverse and submit that that which is not broken need not be fixed. The claims are not rejected under 35 U.S.C. §112, second paragraph; hence, they are not indefinite. The Office Action contains no allegation that the specification fails to meet the Written Description or Enablement requirement under 35 U.S.C. §112 first paragraph for these terms; hence, the specification sufficiently enables and shows possession of these concepts by the inventors at the time the application was filed. Although the precise term “computer-readable medium” is not identically recited in the written description, it is a well-known term of art, the meaning of which are readily ascertainable upon reading the specification. As acknowledged in MPEP 2173.05(e), quoted above, there is no requirement in U.S. patent law or regulations that would compel that a specification contain dictionary definitions of every term or phrase used in every claim. For the above reasons, reconsideration and retraction of this requirement is respectfully requested.

***Claim Rejections – Mahalingam and Vega***

Claims 1-8, and 10 are rejected under 35 U.S.C. § 103(a) for being unpatentable over U.S. Patent 6,208,616 to Mahalingam et al. (hereinafter referred to as “Mahalingam”) in view of U.S. Patent 7,136,800 issued to Vega (hereinafter referred to as “Vega”).

**Claims 1 and 51 are allowable because prior art references Mahalingam and Vega fail to teach or suggest each and every feature set forth in said claims.**

For obviousness under 35 U.S.C. § 103(a), each and every claimed feature must be taught or suggested by the prior art reference, or references when combined or modified (MPEP 2143). Applicant need only point out a single feature in each claim that is not disclosed, taught, or suggested by any reference identified in the Office Action to overcome the prior art-based rejection. The following discussion therefore should not be construed as an exhaustive listing of every distinguishing feature set forth in the claims.

The Office Action includes an admission that “Mahalingam does not teach using VM-specific information in the decision making process.” However, the Office Action states that Vega “explicitly teaches using VM-specific information . . .to manage the host computer’s resources” (Office Action, page 4 lines 20-24). Applicants agree with these statements. However, neither Mahalingam nor Vega specifically teach managing NICs using both NIC management information and VM-specific information as set forth in claims 1 and 51.

Specifically, claims 1 and 51 set forth the step of “based on the . . . VM-specific information, selecting a NIC from the plurality of NICs and transferring the outgoing data frame to the computer network over the selected NIC”. While Applicants agree that Mahalingam does discuss selecting a NIC from a plurality of NICs, that decision is based ***only*** on the NIC management information (e.g., failover status and load balancing information). There is no suggestion in Mahalingam to select a NIC based on VM-specific information or even any information that is analogous thereto. Likewise, Vega does not teach or suggest selecting a resource from a plurality of like resources based on VM-specific information. Rather Vega deals ***exclusively*** with allocating a percentage (or fraction) of a unitary resource, i.e., processor capacity. Claims 1 and 51 should therefore be allowed because neither Vega nor Mahalingam teach or suggest, “based on the . . . VM-specific information, selecting a NIC from the plurality

of NICs and transferring the outgoing data frame to the computer network . . . .” as set forth in claims 1 and 51.

Furthermore, the Office Action provides no rationale to support the modifications to either or both Mahalingam and Vega that would be required to meet the features set forth in the claims discussed above. Thus, the rejections set forth with respect to Mahalingam and Vega fail to satisfy the explicit analysis required to sustain a rejection as set forth in *In re Kahn*, 441 F. 3d 977, 998 (Fed. Cir. 2006) as cited with approval by the United States Supreme Court in *KSR International, Co., v. Teleflex, Inc.*, 127 S.Ct. 1727 (2007).

Claims 1 and 51 are allowable because the prior art lacked motivation to combine and/or modify Mahalingam and Vega in the manner proposed by the Office Action, and to the extent that motivation existed, there would not have been a reasonable expectation for success in the combining of Mahalingam with Vega.

For an obviousness type rejection, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings (MPEP 2143.01). If motivation is found, then there must still be a reasonable expectation of success in making the combination of references (MPEP 2143.02.I).

Motivation to combine the references is lacking because, for example, Vega is directed to allocating a percentage (or fraction) of a unitary resource, i.e., processor capacity, which is inapplicable to NIC management. The Examiner’s contention that “[a]though Vega is directed to allocating processor time, one skilled in the art understands that a NIC is a computer resource and the same allocation methods can be used” (Office Action, page 5, lines 1-2) is incorrect; the techniques described by Vega for allocating processor resources using VM-specific information cannot be applied to managing a plurality of NICs, as explained in more detail below. Furthermore, Vega is solely directed to managing “processor resources.” There is nothing in Vega, or any other cited reference, that would have led a person of ordinary skill to conceive of applying the techniques of Vega to a NIC management scheme. This is because of the fundamental differences between processor resources and multiple NICs.

For example, processor resources may be allocated among a plurality of VMs simply by making scheduling decisions for the VMs. See, e.g., col. 7, lines 57-61 of Vega. When a VM is

descheduled so that a different VM can execute, it is like hitting a “pause” button, in that there is no activity in that VM during the time it is descheduled. However, when a VM is denied access to a NIC, the VM may still be executing and in fact be generating outgoing data frames, which queue up over time due to the non-availability of the assigned NIC. This causes additional complexities not envisioned by Vega. The present invention describes various mechanisms for dealing with this situation that do not map to any analogous function in Vega. For example, claim 67 (previously part of claim 1) sets forth discarding an outgoing data frame when a NIC is not available. Vega doesn’t contemplate simply discarding instructions from a descheduled VM that cannot be executed, because while outgoing data frames may be discarded without materially affecting the operation of a VM, the instructions must be executed. Since one can’t simply “pause” a stream of outgoing packets like you can a stream of instructions executing on a processor, there would not have been a likelihood of success in applying the teachings of Vega to managing a plurality of NICs unless there is some modification to either or both of Mahalingam and Vega in making the claimed combination. However, there was, at the time the invention was made, no motivation to do so.

In combining Vega with Mahalingam, the Office Action states:

“Motivation to combine these references is common knowledge in the art. Using thread / process specific information (such as priority) is well known when allocating processor time in a multithreaded environment. Logical partitions are a natural extension of a multithreaded operating system, and thus using VM specific information to allocate resources would have been obvious to one of ordinary skill in the art”

(Office Action, page 5, lines 2-7). Applicants respectfully agree that using VM specific information was known to allocate resources as exemplified by Vega. However, this does not satisfy the requirement of a cogent analysis<sup>1</sup> as to how a person having ordinary skill in the art, at the time the invention was made, could have used the teachings of Vega and Mahalingam to arrive at Applicants’ claimed invention, particularly the operation of “based on the . . . VM-specific information, selecting a NIC. . . .”

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<sup>1</sup> See *In re Kahn*, 441 F. 3d 977, 998 (Fed. Cir. 2006) as recently cited with approval by the United States Supreme Court in *KSR International, Co., v. Teleflex, Inc.*, 82 USPQ2d 1385 (2007).

Applicants respectfully note that in *KSR*, *infra* obviousness was concluded where “all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1395 (2007). In the present case, the elements cannot be combined “with no change in their respective functions.” Once one accepts the notion that the allocation algorithm supplied in Vega cannot be directly used to make a NIC selection due to the disparate natures of the two different types of computer resources, then that person must accept that some adaptation of Vega would be necessary to make management decisions for a plurality of NICs based on VM-specific information. Without such adaptation, there would not have been a reasonable expectation of success. Hence, the facts of the present case cannot be compared with those in *KSR*.

For the reasons set forth above, Applicants respectfully submit that the prior art fails to teach each and every feature set forth in claims 1 and 51, and since there a combination of the references would not have been successful without making significant modifications, there was no suggestion or motivation in the prior art to combine the references. Furthermore, there was no motivation to modify the references as necessary to obtain the features set forth in claims 1 and 51. Since the Office Action provides no such motivation it can be inferred that the Examiner is instead relying on improper hindsight analysis.<sup>2</sup> Accordingly, Applicants respectfully submit that claims 1 and 51 are allowable over the prior art of record, and early allowance of the same is respectfully requested.

Each of claims 2-11, 13, 14, 52-63, and 67-70 depend from either of claims 1 and 51, and further distinguish from the prior art. With regard to features set forth in claims 67 and 69, (previously residing in claims 1 and 51, respectively) the Office Action states that the argument that neither Mahalingam nor Vega disclose deciding whether to transfer the data “is not persuasive because Mahalingam does disclose this step as a decision state where it is decided whether or not a packet should be transferred . . . and if it is decided not to transfer, the packet is

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<sup>2</sup> *In re Kahn*, 441 F. 3d 977, 998 (Fed. Cir. 2006) (“When the Board does not explain the motivation, or the suggestion or teaching, that would have led the skilled artisan at the time of the invention to the claimed combination as a whole, we infer that the Board used hindsight to conclude that the invention was obvious” (citation omitted).)

discarded” (Office Action, page 3, lines 2-6; and page 4, lines 18-19). Applicants respectfully point out that claim 67 (and corresponding claim 69) sets forth, “discarding the *outgoing* data frame if a decision is made not to transfer the outgoing data frame” (claim 67, line 4; emphasis added) whereas Mahalingam discloses discarding only *incoming* data frames. Since Mahalingam does not teach discarding outgoing data frames, Applicants respectfully submit that claims 67 and 69 are patentable over Mahalingam and cited references.

### *Claim Rejections – Macchiano*

Claim 30 is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 7,111,303 issued to Macchiano et al. (hereinafter referred to as “Macchiano”) in view of Vega and Mahalingam. Claim 64 is a “Beauregard” style claim that generally corresponds in scope to the claim 30, which is a method claim. Claims 49 and 50 depend from claim 30, whereas corresponding claims 65 and 66 depend from claim 64. Applicants note that the Office Action appears to have swept the claims 49, 50, 65, and 66 in with sets of claims corresponding to earlier claims (see, e.g., Office Action, page 11, last three lines).

The prior art fails to teach or suggest each and every feature set forth in claims 30 and 64. For example, the Office Action states, “Macchiano also discloses, ‘the virtual computer system also comprising a first physical network interface card (NIC) and a second physical NIC for connecting to the computer network’ as describing each user portion having a virtual NIC and the computer system may also contain multiple physical NICs (see col. 3, lines 56-58 and Fig. 1 comp. 42, 44; col. 5, lines 4-6)” (Office Action page 10, lines 12-16). Applicants have carefully reviewed the indicated portions of Macchiano and find no support there for a plurality of *physical* NICs. Macchiano does describe (referring to Macchiano, Fig. 1) a computer system 10 having two guest VMs 12, 14, each having a corresponding *virtual* NIC 42, 44. The indicated portions of the specification of Macchiano likewise only show virtual NICs, not physical NICs. To further clarify this distinction, each recitation of NIC in claims 30, 49, 50, 64, 65, and 66 is amended to recite “physical NIC.”

Furthermore, Macchiano does not disclose “transferring the outgoing data frame over an available one of the physical NICs if the one of the first VMs having higher priority provided the outgoing data frame; or discarding the outgoing data frame if the other of the VMs provided the



outgoing data frame” as now set forth in claims 30 and 64. Furthermore, none of the remaining cited references teach this feature. Applicants respectfully submit that claims 30 and 64, and claims depending therefrom, are allowable and therefore request reconsideration in view of the amendments now made to these claims.

Additional dependent claims not specifically addressed above should be allowed for at least the reasons mentioned above with respect to claims from which the additional dependent claims depend. Accordingly, Applicants respectfully submit that the present Application is in condition for allowance. Applicants respectfully request reconsideration of the outstanding rejections in light of the above and a Notice of Allowance. The Examiner is invited to contact the undersigned at 650-427-2390 to discuss any additional changes the Examiner may feel is necessary in light of this Amendment.

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Respectfully submitted,

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